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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,414	10/12/2000	Howard J. Glaser	STL920000091US1	1232
24852	7590	11/09/2004	EXAMINER	
INTERNATIONAL BUSINESS MACHINES CORP IP LAW 555 BAILEY AVENUE , J46/G4 SAN JOSE, CA 95141			NGUYEN BA, HOANG VU A	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

05

Office Action Summary	Application No. 09/687,414	Applicant(s) GLASER ET AL.	
	Examiner Hoang-Vu A Nguyen-Ba	Art Unit 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed July 16, 2004.
2. Claims 1, 3-7, 9-13 and 15-18 are pending.

Response to Amendment

3. Per Applicants' request, claims 3, 9 and 15 have been amended.

Response to Arguments

4. Applicants' arguments with respect to claims 1, 3-7, 9-13 and 15-18 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 15-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A single claim, which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

In claim 13, it is unclear whether a computer system or a method for downloading an application program is claimed. With a computer system recited in the preamble, one would expect to find in the body of the claim, components having functions to download an application program. However, one found a mixture of software components (e.g., a stored user configuration of the application program, a manifest file, a decryptor, a downloader) and method steps for establishing a local-remote connection (e.g., session, authentication).

Claims 15-18, which depend from claim 13, are also rejected for the same reason.

Correction is required.

Claim Rejections – 35 USC § 101

7. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 13 and 15-18 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Pursuant to claim 13, a single claim which claims both an apparatus and the method steps of using the apparatus should also be rejected under 35 U.S.C. 101, *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), based on the theory that the claim is directed to neither a “process” nor a “apparatus,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claims 15-18, which depend from claim 13 are also rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Correction is required.

Claim Rejections – 35 USC § 103

9. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-7, 9-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,205,476 to Hayes, Jr. ("Hayes") in view of U.S. Patent No. U.S. Patent No. 5,894,515 to Hsu.

Claims 1, 7 and 13

Hayes discloses at least:

defining and storing a user configuration of the application program corresponding to the particular user of the application program (see at least Figures 9, 10, 11 and related discussion in the specification);

storing the user configuration in a manifest file (see at least Figure 11, step 1107 and related discussion in the specification);

initiating a session between the local data processing system and the remote data processing system in response to the particular user requesting the application program (see at least Figures 9, 10, 11 and related discussion in the specification);

authenticating the particular user in response to the particular user requesting the application program (see at least Figures 9, 10, 11 – e.g., ID, Password -- and related discussion in the specification);

responsive to the user authentication, downloading data from the remote data processing system to the local data processing system according to the user configuration (see at least Figures 9, 10, 11 – e.g., ID, Password -- and related discussion in the specification).

Hayes does not specifically disclose *encrypting* and *decrypting*. However, Hsu teaches encrypting data (see at least 1:13-21). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Hsu's encrypting feature to Hayes, as this feature would provide protection for Hayes' configuration files.

Claims 3, 9 and 15

Hayes in view of Hsu further discloses *wherein the manifest file is stored on the remote data processing system, wherein the computer program embodied in said medium causes the data processing system to execute the additional method comprising: downloading the manifest file from the remote data processing system to the local data processing system, wherein the manifest file is decrypted to produce a downloaded user configuration in response to the user authentication, and wherein the data is downloaded from the remote data processing system according to the downloaded user configuration* (see at least Figures 9, 10, 11 and related discussion in the specification).

Claims 4, 10 and 16

Hayes in view of Hsu further discloses *building the application program pursuant to the user configuration decrypted from the manifest file responsive to a second authentication* (see at least Figure 11, steps 1112, 1114, 1116, 1118 and related discussion in the specification).

Claims 5, 11 and 17

Hayes in view of Hsu further discloses:

authenticating the particular user in the second authentication responsive to the particular user requesting a build of the application program (see at least Figures 9, 10, 11 – e.g., ID, Password -- and related discussion in the specification);

decrypting the manifest file responsive to the second authentication (see at least Figure 11, step 1112, 1114, 1116, 1118 and related discussion in the specification);

building the application program pursuant to the user configuration decrypted from the manifest file responsive to the second authentication (see at least Figure 11, steps 1112, 1114, 1116, 1118 and related discussion in the specification).

Claims 6, 12 and 18

Hayes further discloses *wherein the user configuration comprises data describing the particular user, the particular user's application program configuration, and resources for which the particular user is authorized* (see at least Figures 9, 10, 11 and related discussion in the specification).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hoang-Vu A Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday, 6:00 – 16:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Tuan Dam can be reached at (571) 272-3695.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Hoang Anthony Nguyen Ba". The signature is written in a cursive, flowing style.

ANTONY NGUYEN-BA
PRIMARY EXAMINER

Art Unit 2122

November 3, 2004